

Remarks

In view of the following amendments and remarks, favorable reconsideration of the outstanding office action is respectfully requested. Claims 1 – 21 remain in this application. Claims 6 and 11 have been canceled. Claims 16 – 18 have been withdrawn from consideration, without prejudice.

1. Allowed Claims/Subject Matter

Applicant notes with appreciation that the Examiner has indicated the subject matter of claims 10, 13, and 15 are patentable, and would be allowable if rewritten in independent form.

2. § 103 Rejections

The Examiner has rejected claims 1 – 5, 7 – 9, and 19 – 21 under 35 U.S.C. § 103 as being unpatentable for obviousness over U.S. Patent No. 2,380,793 to Rugg in view of U.S. Patent No. 6,545,216 to Bell et al. (hereinafter Bell).

Rugg is directed to an outlet box support consisting of back plate support 7 and clamping member 8. Outlet box 2 includes a base member 4 having a central circular hole 6 and a plurality of holes 5 disposed around the central hole 6. The support also includes a back plate support 7 that has slots 10 and ears 12. Support also includes a clamping frame 8 that includes two side arms 14. The support is assembled by inserting the ears 12 into the holes 5 such that support 7 is disposed over the central hole 6. Subsequently, the side arms 14 of clamping frame 8 are inserted into the slots 10 of back support 7. Finally, screw element 9 is inserted into clamping frame 8 and support 7 to thereby position outlet box 2 between back plate support 7 and clamping frame 8. As shown in Figure 2, the clamping frame 8 includes bar hanger openings 15. Accordingly, the stated purpose of the Rugg invention is to support outlet box 2 with a bar hanger 1.

Bell discloses an electrical box 10 having one or more fixture supports 40 disposed in a side portion of an electrical box. The base portion 16 is attached to a structural member, such as a joist, by way of apertures 26 and 28.

According to the **MPEP 2143**, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A. The Examiner does not show where the prior art references teach or suggest all the claim limitations:

Claim 1: The Examiner admits that neither Rugg nor Bell, whether taken alone, or in combination, teach or suggest an electrical box that has a base member that includes a plurality of slots. Instead, the Examiner states that Rugg's base member 4 along with back support 7 "together constitute the base member." See page 2 of the Office Action. The applicants are entitled to define claim terms, not the Examiner. The claims unambiguously recite an *electrical box including a base member,...the base member also including a plurality of slots...* It is manifestly improper for the Examiner to redefine claim language in support of a rejection. The electrical box disclosed by Rugg does not include slots. It has a central aperture 6. The Examiner is attempting to redefine what an electrical box is. According to the instant specification, the electrical box is a single element. Rugg discloses a single box that does not include slots. Accordingly, neither reference discloses an electrical box having slots.

The Examiner's rejection fails to address or consider all of the claimed limitations. Specifically, claim 1 recites "*a mounting assembly including a plurality of tab members configured to be inserted into the plurality of slots such that the plurality of tab members and the base member form a channel, the channel being configured to receive the structural member therein...*" The Examiner fails to point to any portion of Rugg or Bell that has these features. Indeed, the Examiner cannot point to any such features in the references because these references do not in any way disclose the claimed invention.

Accordingly, the Examiner has not shown where Rugg or Bell, whether taken alone, or in combination, teach or suggest all of the claim limitations.

B. There is no proper motivation to combine references

There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

As noted in the applicants' last communication, the prior art does not suggest the desirability of the combination because the secondary reference (Bell) changes the principle of operation of the primary reference (Rugg). It is well settled that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In this case, the inventor of the primary reference, Edward Rugg, explicitly states "A box as shown in the drawing is standardized in the wiring industry...My invention has to do with a means for mounting such a standardized box *on a bar hanger*." See col. 1, lines 40 – 41. Bell, on the other hand, discloses holes 26 and apertures 28, which are used to accommodate screws and/or nails for directly "attaching the electrical box to studs, braces, or joists." See col. 3, lines 42 – 53.

Instead of providing a substantive response to the above stated arguments, the Examiner has chosen to insert a form paragraph taken from the patent office database. The Examiner then argues that Bell and Reiker can be combined, essentially, because both are directed to electrical boxes. Accordingly, the Examiner failed to answer the applicants' arguments regarding the combinability of Rugg and Bell.

C. The Examiner has also rejected claims 12 and 14 under 35 U.S.C. § 103 as being unpatentable for obviousness over Rugg in view of Bell, and further in view of U.S. Patent No. 6,207,897 to Reiker. The applicants point out that the Examiner makes no representation that Reiker overcomes any of the deficiencies of Rugg and Bell with respect to claim 1. Therefore the dependent claims, while allowable in their own right, are also allowable by virtue of their dependency from claim 1.

Accordingly, the applicants respectfully assert that claims 1 – 5, 7 – 9, and 19 – 21 are patentable under 35 U.S.C. § 103 because the Examiner does not make a prima facie case for obviousness. Thus, the applicants respectfully request that the rejection under 35 U.S.C. § 103 be withdrawn.

5. Conclusion

Based upon the remarks and papers of record, Applicants believe the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims 1 – 5, 7 – 10, and 12 – 21 and a prompt Notice of Allowance thereon.

Applicants believe that no extension of time is necessary to make this Response timely. Should Applicants be in error, Applicants respectfully request that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 50-1546.

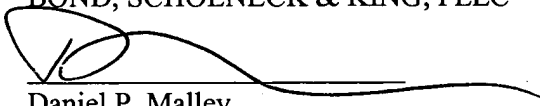
Please direct any questions or comments to Daniel P. Malley at (607) 330-4010.

Respectfully submitted,

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2-21-06


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